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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Corinne Bortolin et al.

Application No.: 10/676,382

Filed: September 30, 2003

For: SYSTEM AND APPARATUS FOR  
LINKING MULTIPLE REWARDS  
PROGRAMS TO PROMOTE THE  
PURCHASE OF SPECIFIC PRODUCT  
MIXES IN SUPPORT OF BROADER  
MARKETING STRATEGIES

Confirmation No. 9159

Examiner: Daniel Lastra

Technology Center/Art Unit: 3688

APPELLANTS' BRIEF UNDER  
37 CFR §41.37

Mail Stop Appeal Brief  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Commissioner:

Further to the Notice of Appeal mailed on September 29, 2011 for the above-referenced application, Appellants submit this Brief on Appeal.

## TABLE OF CONTENTS

1. REAL PARTY IN INTEREST .....	3
2. RELATED APPEALS AND INTERFERENCES.....	3
3. STATUS OF CLAIMS .....	3
4. STATUS OF AMENDMENTS .....	3
5. SUMMARY OF CLAIMED SUBJECT MATTER .....	3
6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	8
7. ARGUMENT .....	8
8. CONCLUSION.....	19
9. CLAIMS APPENDIX.....	20
10. EVIDENCE APPENDIX.....	25
11. RELATED PROCEEDINGS APPENDIX.....	26

### **1. REAL PARTY IN INTEREST**

The real party in interest of the subject patent application is Visa U.S.A. Inc., the assignee of the application.

### **2. RELATED APPEALS AND INTERFERENCES**

There are no related appeals and interferences.

### **3. STATUS OF CLAIMS**

Claims 21-32, 34-37, and 39-52 are pending and are finally rejected. Claims 1-20, 33, and 38 were previously cancelled. Appellant appeals from the rejection of all pending claims.

### **4. STATUS OF AMENDMENTS**

None.

### **5. SUMMARY OF CLAIMED SUBJECT MATTER**

In the following summary, Appellant has provided exemplary references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. § 41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, these references are only intended to be illustrative and not restrictive.

In today's environment, marketing programs are typically tailored by individual retailers to incentivize customers to purchase individual products. For example, a store's marketing program may provide for a reward of \$0.25 after the consumer purchases a particular brand of toothpaste.

The effectiveness of such individual programs is limited. For example, individual Retailer H may have a program for marketing Beer X, while Retailer I may have a program for marketing Nuts Y. Retailer H may provide a \$0.50 reward for the purchase of each Beer X and Retailer I may provide a \$0.50 reward for the purchase of each Nuts Y. Retailer H and Retailer I

have maximized the potential sales for Beer X and Nuts Y with these individual marketing programs.

Embodiments of the present invention include methods, systems, and apparatus that provide a way to increase the synergy between pre-existing marketing programs hosted by different merchants (e.g., the marketing program by Retailer H for Beer X and the marketing program by Retailer I for Nuts Y) by providing an award layer above and beyond yet linked to these pre-existing marketing programs. This additional award layer incentivizes customers to engage in these multiple pre-existing marketing programs, thereby purchasing products from multiple merchants, and in some cases incentivizes customers to purchase additional products from each merchant. This is contrast to marketing programs that incentive consumers to purchase goods from only one merchant.

For example, as described with reference to Figure 7 of the subject application (reproduced below), if a consumer purchases bleach W at a first merchant that had a pre-existing marketing program A, they will be issued an award of \$0.50 in accordance with program A (i.e., 80 of FIG. 7). Entirely separate from the first merchant and program A, if a consumer purchases detergent X at another, different, second merchant, that had its own pre-existing marketing program B, they will be issued an award of \$0.75, in accordance with program B (i.e., 82 of FIG. 7). Accordingly, in a typical scenario, if a consumer were to purchase one bleach W and one detergent X they will be issued an overall award of \$1.25.

These reward programs by themselves do not incentive the purchasing of multiple products from different merchants. Rather, they merely operate as stand-alone incentives to individually purchase bleach W or detergent X. However, embodiments of the present invention build on top of these pre-existing marketing programs by providing a combination reward. For example, in the event the consumer purchases bleach W from the first merchant and detergent X from the second merchant, the combination reward may be an additional reward of \$0.50. The provision of such a combination reward advantageously incentivizes consumers to purchase multiple products from multiple, different merchants.

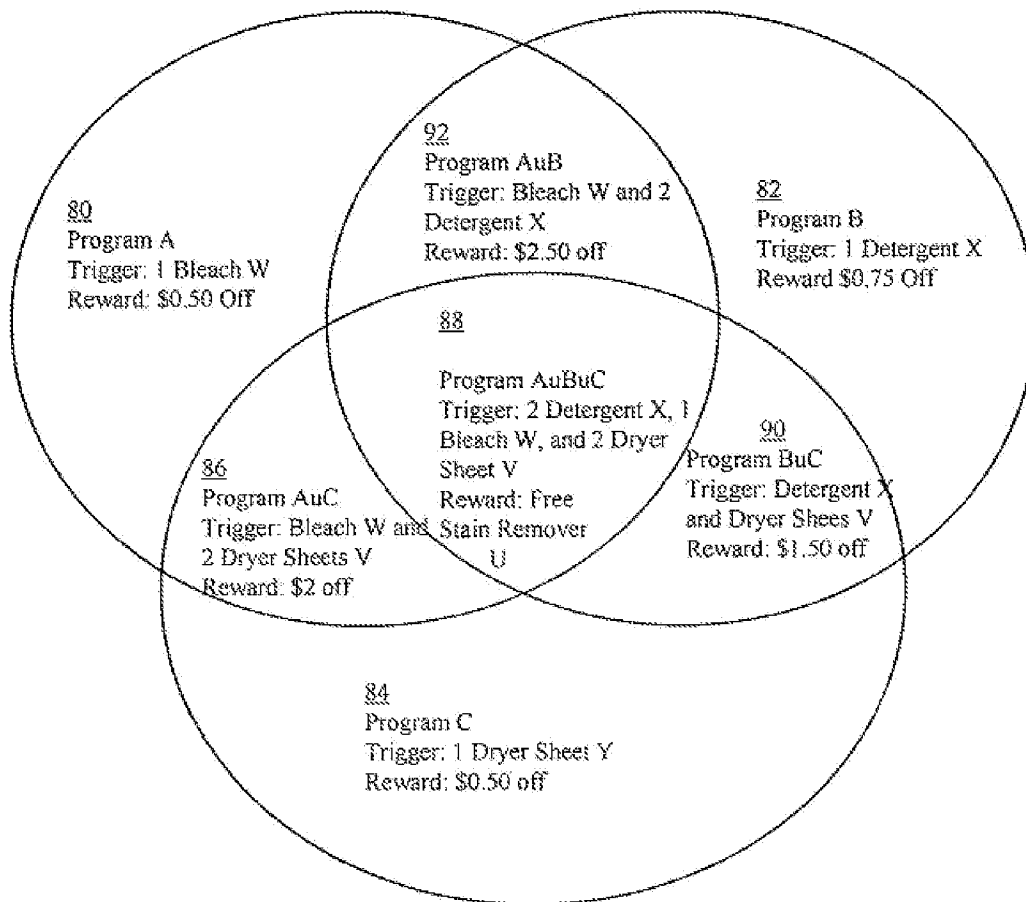


FIG. 7

Independent Claim 21

Claim 21 is directed to a method comprising:

receiving information at a host server computer (52) about a first pre-existing offline reward program created by a first merchant, wherein the first pre-existing offline reward program provides for a first reward when a first product is purchased at the first merchant (page 5, lines 18-21; page 6, lines 10-13; page 6, lines 16-20; page 4, line 24);

receiving information at the host server computer (52) about a second pre-existing offline reward program created by a second merchant, wherein the second pre-existing offline reward program provides a second reward when a second product is purchased at the second merchant (page 5, lines 21-24; page 6, lines 10-13; page 6, lines 16-20; page 4, line 24); and

using the host server computer (52), providing for a combination reward program that is linked to the first pre-existing offline reward program and the second pre-existing offline reward program and that provides a combination reward that is based on the purchase of at least the first product and the second product, (page 6, lines 21-22; page 6, lines 27-28) wherein the combination reward program is provided by a reward sponsor (page 4, lines 4-6; page 4, lines 31-33), wherein the first merchant is different than the second merchant (page 6, lines 16-20), and wherein the combination reward is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location (page 2, lines 9-18; page 7, lines 1-11; page 12, lines 9-15; page 10, lines 27-30), and wherein the first pre-existing offline reward program is capable of running without being in contact with the host server computer, and wherein the second pre-existing offline reward program is capable of running without being in contact with the host server computer (page 1, lines 27-28; page 4, lines 24-29; page 8, lines 5-7);

wherein the portable consumer device includes a dynamic data field that may be updated based on a product preference of the consumer (page 10, lines 7-14).

#### Dependent Claim 30

Claim 30 depends on claim 21. Claim 30 recites wherein the portable consumer device is a smartcard that conforms to ISO standard 7816 (page 10, lines 24-26), wherein the smartcard includes a dynamic data field that is updated each time the first, second, and combination reward programs accumulate or redeem rewards (page 10, lines 9-10).

#### Dependent Claim 45

Claim 45 depends on claim 21. Claim 45 recites wherein the special program is a reward program provided by a credit card processing company (page 8, lines 19-20).

#### Independent Claim 32

Claim 32 is directed a computer readable medium comprising code executable by a host server computer (52) to implement a method (page 2, lines 27-28) comprising:

receiving information at a host server computer (52) about a first pre-existing offline reward program created by a first merchant, wherein the first pre-existing offline reward program provides for a first reward when a first product is purchased at the first merchant (page 5, lines 18-21; page 6, lines 10-13; page 6, lines 16-20; page 4, line 24);

receiving information at the host server computer (52) about a second pre-existing offline reward program created by a second merchant, wherein the second pre-existing offline reward program provides a second reward when a second product is purchased at the second merchant (page 5, lines 21-24; page 6, lines 10-13; page 6, lines 16-20; page 4, line 24); and

using the host server computer (52), providing for a combination reward program that is linked to the first pre-existing offline reward program and the second pre-existing offline reward program and that provides a combination reward that is based on the purchase of at least the first product and the second product, (page 6, lines 21-22; page 6, lines 27-28) wherein the combination reward program is provided by a reward sponsor (page 4, lines 4-6; page 4, lines 31-33), wherein the first merchant is different than the second merchant (page 6, lines 16-20), and wherein the combination reward is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location (page 2, lines 9-18; page 7, lines 1-11; page 12, lines 9-15; page 10, lines 27-30), and wherein the first pre-existing offline reward program is capable of running without being in contact with the host server computer, and wherein the second pre-existing offline reward program is capable of running without being in contact with the host server computer (page 1, lines 27-28; page 4, lines 24-29; page 8, lines 5-7);

wherein the portable consumer device includes a dynamic data field that may be updated based on a product preference of the consumer (page 10, lines 7-14).

Dependent Claim 40

Claim 40 depends on claim 32. Claim 40 recites wherein the portable consumer device is a smartcard that conforms to ISO standard 7816 (page 10, lines 24-26), wherein the smartcard includes a dynamic data field that is updated each time the first, second, and combination reward programs accumulate or redeem rewards (page 10, lines 9-10).

**6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Are claims 21-23, 25, 26, 28, 29, 32, 35, 36, 39, 41-44, and 46-52 obvious under 35 U.S.C. § 103 over Fowler (US Patent Publication 2002/0026348) in view of Fernandez (US Patent Publication 2001/0016827)?

Is claim 24 obvious under 35 U.S.C. § 103 over Fowler in view of Ryan (US Patent Publication 2005/0055272)?

Are claims 27, 34, 37 and 45 obvious under 35 U.S.C. § 103 over Fowler in view of Nerger Monkia “Evening the odds: CRM systems are driving sophisticated loyalty programs at Las Vegas Casinos – and not just for the high rollers,” March 1, 2002?

Are claims 30, 31, and 40 obvious under 35 U.S.C. § 103 over Fowler in view of Postrel (US Patent 6,594,640)?

**7. ARGUMENT**

**I. Rejection of claims 21-23, 25, 26, 28, 29, 32, 35, 36, 39, 41-44, and 46-52 as being obvious over Fowler (US Patent Publication 2002/0026348) in view of Fernandez (US Patent Publication 2001/0016827)**

**A. Independent claim 21**

- 1. The cited art does not teach or suggest “wherein the combination reward is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location” (emphasis added)*



This emphasized aspect of claim 21 is directed to the condition on which a combination reward is provided. That is, a combination reward is given to a consumer “if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location.”

The Examiner relies on Fowler to disclose this feature of claim 21. (Final Office Action dated May 15, 2011; page 3). As an initial matter, Fowler is directed to a real-time, automated marketing program implementing one or more program rules matrix modules that calculate benefits to customers based on one or more customer identifier(s), one or more merchant identifier(s) and one or more customer behavior(s). (Fowler, abstract). For example, with reference to Figure 1 of Fowler (reproduced below), Fowler discloses a system 10 including multimedia terminals 14 (e.g., point of sale terminals) for inputting customer and/or merchant and/or transaction information. The multimedia terminals 14 are connected to a host controller 12 having software modules 40 via various elements (such as network interface 18), where the software modules 40 enable the systems and methods disclosed by Fowler. (Fowler, paragraph [0057]). Figure 2 (also reproduced below) shows a simplified flow chart 100 for implementing the marketing systems and methods of Fowler. At the time of a transaction, various information (e.g., a customer identifier) may be received from a point of sale terminal. If the point of sale terminal is valid, and the customer identifier is valid, then a rate calculation module 108 is activated, where an award is determined. Then, an optional win processing module 110 (e.g., a “Swipe ‘N’ Win”) is executed to determine whether this additional benefit is to be awarded. (Fowler, paragraphs [0067]-[0071]).

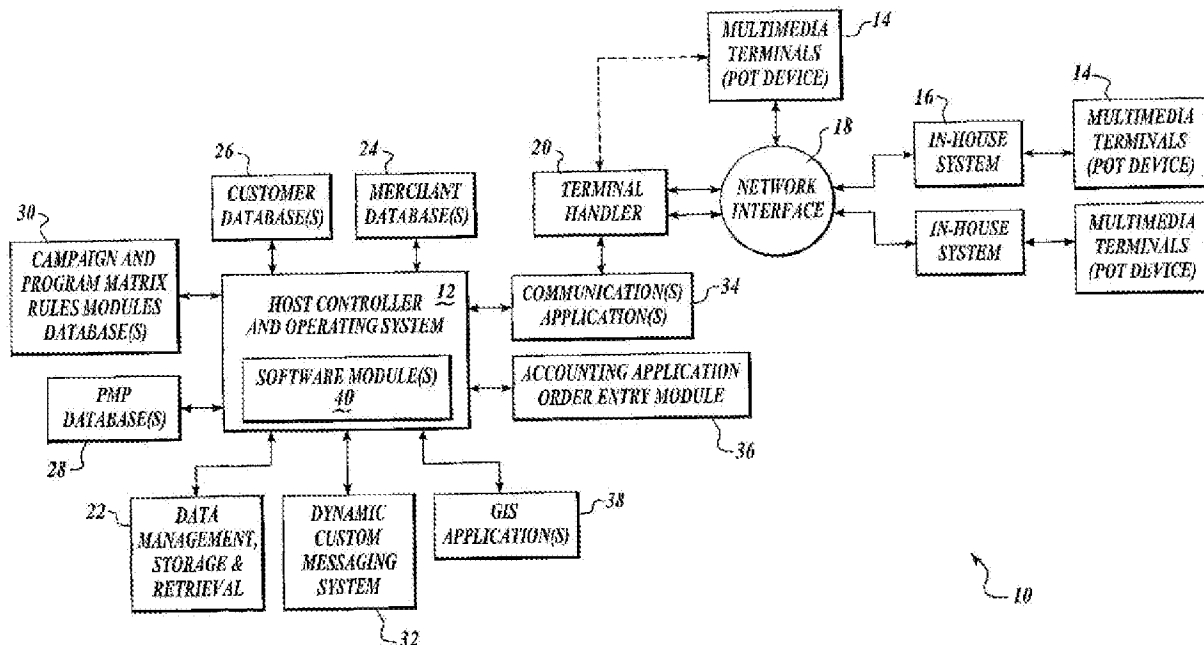


FIG. 1

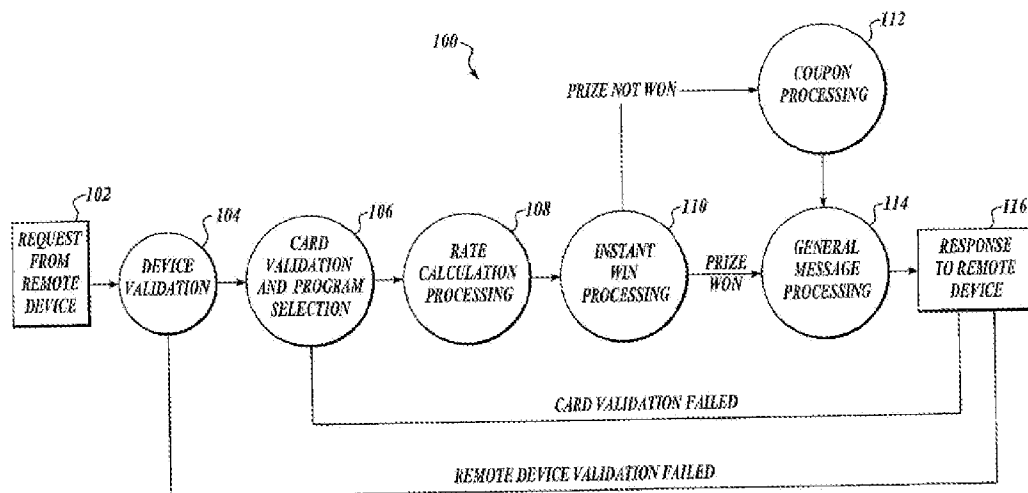


FIG. 2

The Examiner specifically relies on Fowler's disclosure that "multiple awards programs may be operated based on a single qualifying transaction." (Final Office Action dated May 16, 2011; page 3; Fowler, paragraphs [0026]-[0031], [0083], [0103]). However, nowhere in

this cited disclosure does Fowler teach or suggest the condition “if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location.”

Appellant respectfully disagrees that this disclosure of Fowler teaches or suggests the claimed conditions on which a combination reward is provided. This disclosure states that multiple awards programs may be operated based on a single qualifying transaction. This means that for a single transaction at a single merchant (e.g., with reference to Figure 5 of Fowler, purchasing goods at “STREET STYLE”), the consumer may be provided multiple awards (e.g., 2 “Points” and a “\$15 REWARD COUPON”) for engaging in that single transaction with that single merchant. However, this is entirely different than the claimed combination reward, since the combination reward as claimed is provided based on multiple, not single, product purchases, and not only multiple product purchases, but multiple product purchases at different merchants.

The Examiner also relies on Fowler’s disclosure that “multiple benefits from a number of marketing programs may be awarded.” (Final Office Action dated May 16, 2011, page 3; Fowler, paragraph [0080]; see also Advisory Action dated September 9, 2011, paragraph 11). Appellant submits that this disclosure in Fowler is no more relevant to the claimed invention than that discussed in the preceding paragraph. Here, similar to the aforementioned disclosure in paragraph [0103], Fowler discloses that multiple benefits may be awarded. However, the full sentence is “In alternative embodiments of the present invention, multiple benefits from a number of marketing programs may be awarded.” Paragraph [0103] does not say multiple benefits from a number of marketing programs may be awarded if a consumer uses a portable consumer device to purchase a first product at a first merchant at a first location and to purchase a second product at a second merchant at a second location. In fact, when read in context, paragraph [0080] suggests at most awarding one or more benefits per transaction. That is, paragraph [0080] recites (“For example, one embodiment of the present invention may only award one benefit per transaction, and if multiple benefits are awarded, ... collision detection software will prioritize which benefit is to be awarded.”) Accordingly, the recitation of “multiple benefits from a number of marketing programs” is directed to providing such benefits in response to a single, not multiple, transactions, much less multiple transactions from different

merchants at different locations, and thus fails to teach or suggest the aforementioned features of claim 21 for at least the same reasons as the citation of Fowler in paragraph [0103] as discussed above.

In addition to these technical differences between the invention recited in claim 21 and the disclosure of Fowler, it should be recognized that at least due to these differences, Fowler fails to teach or suggest the aforementioned advantages associated with the claimed invention. That is, as mentioned, the provision of the additional reward in addition to and separate from the first two awards (which are provided by different award programs and merchants) advantageously incentives consumers to purchase products from numerous different merchants. In contrast, the previously discussed technical features of Fowler (i.e., operating multiple awards programs based on a single qualifying transaction), merely incentivize a consumer to engage in that single qualifying transaction with the single, particular merchant.

The other relied upon reference, *Fernandez*, is directed to methods and apparatus for electronically storing and retrieving value information on a portable card. *Fernandez* is not alleged to, and in any event fails to, cure the deficiencies of *Fowler*.

2. *The cited art does not teach or suggest, inter alia, “providing for a combination reward program that is linked to the first pre-existing offline reward program and the second pre-existing offline reward program ... wherein the first pre-existing offline reward program is capable of running without being in contact with the host server computer, and wherein the second pre-existing offline reward program is capable of running without being in contact with the host server computer”*

This emphasized aspect of claim 21 is directed to the provision of a reward program that is linked to other pre-existing offline reward programs. For example, with reference to Figure 7, a first pre-existing offline reward program may be one that is operated by a first merchant, such as Program A, and a second pre-existing offline reward program may be one that is operated by a second merchant, such as Program B, whereas the host server may receive information about each of Program A and Program B so as to generate a combination reward program, such as Program AuB.

The Examiner alleges that paragraphs [0026]-[0031] of Fowler teach “providing for a combination reward program that is linked to the first pre-existing reward program and the second pre-existing reward program (Final Office Action, page 3), and then relies on [0023]-[0024] and [0027] of Fernandez to teach “wherein the first pre-existing offline reward program is capable of running without being in contact with the host server computer, and wherein the second pre-existing offline reward program is capable of running without being in contact with the host server computer” (Final Office Action, page 4).

Fernandez discloses that a loyalty program can be operated in a read/write unit 104A (see FIG. 1 of Fernandez) provided by a supplier, where the read-write units 104 may periodically connect with a central server 106 to perform various online functions. (Fernandez, paragraphs [0023], [0024], and [0027]). However, Fernandez says nothing about linking a combination reward program to pre-existing offline reward programs since the loyalty program operated by the read/write unit 104A is the same as that operated by the central server 106. Fowler fails to cure this deficiency of Fernandez since Fowler does not even allegedly disclose offline reward programs, much less linking between a combination reward program and multiple pre-existing offline reward programs.

According to the Examiner, it would be obvious to modify Fowler “to download loyalty parameters to POS terminals.” (Final Office Action, page 4). Looking at Fowler (e.g., FIG. 1), it appears that the Examiner is suggesting it would obvious to modify Fowler such that loyalty parameters are downloaded from host controller 12 to multimedia terminals 14. However, even if Fowler was so modified, the resulting device still would not provide a combination reward program that is linked to pre-existing reward programs. Instead of having one reward program (e.g., a “combination reward program”) executed by the host controller 12 being linked to multiple other programs (e.g., “pre-existing offline reward program(s)” executed by multimedia terminals 14, the same reward program (e.g., the “combination reward program”) would merely be downloaded from the host controller 12 to each of the multimedia terminals 14. This is in stark contrast to claim 21 which recites the linking of different reward programs. Moreover, claim 21 recites the linking of a combination reward program to pre-existing offline

reward programs, an additional difference between the claimed “offline reward program(s)” that is also not taught or suggested by either Fowler or Fernandez.

3. *The cited art does not teach or suggest, inter alia, “wherein the portable consumer device includes a dynamic data field that may be updated based on a product preference of the consumer”*

This emphasized aspect of claim 21 is directed to the provision of a dynamic data field in a portable consumer device that may be updated based on a product preference of the consumer. For example, although not so limited by the claims, a consumer may have a personal preference for a particular soap, shampoo, or other toiletry. The dynamic data field of the portable consumer device may be updated based on this preference. This preference may then be used to customize future rewards, such as by the generation of a reward program that includes a reward in the event the consumer purchases that particular soap, shampoo, or other toiletry. The provision of such a data field may result in numerous advantages, such as being able to generate a reward program around the preferred product and consequently increase the likelihood of future sales.

The Examiner relies upon Fowler’s disclosure that “a point of transaction may also be a PDA” to teach this element. (Final Office Action dated May 16, 2011, pages 3-4; Fowler, paragraph [0090]). Appellant respectfully disagrees that this disclosure of Fowler teaches or suggests the aforementioned feature. This disclosure simply states that a point of transaction device may be a personal computer such as a PDA. However, the mere disclosure of a PDA says nothing about product preferences of consumers, much less the inclusion of a dynamic data field that may be updated based on a product preference as recited in claim 21.

The Examiner also relies upon Fowler’s alleged disclosure that a smartcard may be updated with current loyalty information such as current points or lifetime cumulative points. (Final Office Action dated May 16, 2011, pages 3-4; Fowler, paragraphs [0083]-[0085]). However, Appellant respectfully submits that this cited portion of Fowler says nothing about a smartcard being updated with current loyalty information. Of this cited portion, only paragraph [0085] discloses “current points” and “lifetime cumulative points”. However, here, Fowler is

disclosing that such information may be “textual information provided on a statement”, which may be visualized in Figures 5 and 6 of Fowler (see point C of Fowler FIGS. 5 and 6). This is merely teaching that such information may be printed on a receipt provided by a merchant, although there is no teaching or suggestion that such information may be stored on the smartcard of Fowler, and even if it was, this information has nothing to do with a consumer’s product preferences.

In addition to these technical differences between the invention recited in claim 21 and the disclosure of Fowler, it should be recognize that at least due to these differences, Fowler fails to teach or suggest the aforementioned advantages associated with the claimed invention. That is, as mentioned, the provision of a portable consumer device that includes a dynamic data field that may be updated based on a product preference of the consumer advantageously enables merchants or other entities to customize future rewards. In contrast, the previously discussed technical features of Fowler (e.g., printing point update information on a merchant-issued receipt) merely provides point information to a consumer.

The other relied upon reference, *Fernandez*, is directed to methods and apparatus for electronically storing and retrieving value information on a portable card. *Fernandez* is not alleged to, and in any event fails to, cure the deficiencies of *Fowler*.

For each and all of these reasons, *Fernandez* and *Fowler* fail to render independent claim 21 obvious. Claims 22-23, 25, 26, 28, 29, 42-44, and 46-50 depend on claim 21 and are thus not rendered obvious by *Fernandez* and *Fowler* for at least the same reasons as claim 21.

B. Independent claim 32

The combination of *Fernandez* and *Fowler* fail to teach or suggest numerous features recited in claim 32. For example, *Fernandez* and *Fowler*, either alone or in combination with one another, fail to teach or suggest “wherein the combination reward is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase

the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location”, “providing for a combination reward program that is linked to the first pre-existing offline reward program and the second pre-existing offline reward program ... wherein the first pre-existing offline reward program is capable of running without being in contact with the host server computer, and wherein the second pre-existing offline reward program is capable of running without being in contact with the host server computer”, and “wherein the portable consumer device includes a dynamic data field that may be updated based on a product preference of the consumer” at least for reasons similar to those discussed above with reference to claim 21.

For each and all of these reasons, *Fernandez* and *Fowler* fail to render independent claim 32 obvious. Claims 35, 36, 39, 41, and 51-52 depend on claim 32 and are thus not rendered obvious by *Fernandez* and *Fowler* for at least the same reasons as claim 32.

**II. Rejection of claim 24 as being obvious over Fowler in view of Ryan (US Patent Publication 2005/0055272)**

The rejection to claim 24 relies on *Fowler* teaching all of the features of claim 21. However, as discussed above with respect to claim 21, *Fowler* does not teach or suggest all of the features of claim 21. *Ryan* is directed to a method and system for providing benefits to retail consumers. *Ryan* is not alleged to nor does it cure the deficiencies of *Fowler*. For at least this reason, *Fowler* and *Ryan* fail to render claim 24 obvious.

**II. Rejection of claims 27, 34, 37 and 45 as being obvious over Fowler in view of Nerger Monkia “Evening the odds: CRM systems are driving sophisticated loyalty programs at Las Vegas Casinos – and not just for the high rollers,” March 1, 2002**

The rejection to claims 27, 34, 37, and 45 relies on *Fowler* teaching all of the features of claims 21 and 32. However, as discussed above with respect to claims 21 and 32, *Fowler* does not teach or suggest all of the features of claims 21 and 32. *Nerger Monkia* is directed to CRM systems. *Nerger Monkia* is not alleged to nor does it cure the deficiencies of



*Fowler*. For at least this reason, *Fowler* and *Nerger Monkia* fail to render claims 27, 34, 37, and 45 obvious.

Claim 45

Claim 45 recites “wherein the special program is a reward program provided by a credit card processing company.” According to the Office Action, *Fowler* does not teach this claim element, however:

“Evening the odds teaches that it is old and well known in the promotion art to have loyalty programs (i.e. payment card or loyalty card) where a customer receives preferential treatment, such as access to transportation earlier in time than other customers (i.e., not need to wait in line) when said earned enough loyalty points to achieve a specific tier level (see page 1). Therefore, it would have been obvious to a person ordinary skill in the art at the time the application was made, to know that *Fowler* would offer a customer that has purchased two products access to special programs earlier than other customers that had not purchased said two products and had not earned enough loyalty points, as the claimed invention is simply a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.” (Office Action, page 8, last paragraph)

However, nowhere in this rejection does the Office Action indicate how or where the “Evening the odds” reference teaches or suggests “wherein the special program is a reward program provided by a credit card processing company” as recited in claim 45. Although Appellant does not necessarily agree, even if what the Examiner contends is taken as true, that it is old and well known to have loyalty programs “where a customer receives preferential treatment”, preferential treatment of customers has nothing to do with the identity of the entity providing the “special program” recited in claim 45. Further, as admitted by the Examiner, *Fowler* fails to teach this claim element. Accordingly, the Examiner has failed to establish a prima facie case of obviousness for claim 45 and, for at least this reason, withdrawal of the outstanding rejection to claim 45 is respectfully requested.

**II. Rejection of claims 30, 31, and 40 as being obvious over *Fowler* in view of Postrel (US Patent 6,594,640)**

The rejection to claims 30, 31, and 40 relies on *Fowler* teaching all of the features of claims 21 and 32. However, as discussed above with respect to claims 21 and 32, *Fowler* does not teach or suggest all of the features of claims 21 and 32. *Postrel* is directed to a system for electronic barter, trading and redeeming points accumulated in frequent use reward programs. *Postrel* is not alleged to nor does it cure the deficiencies of *Fowler*. For at least this reason, *Fowler* and *Postrel* fail to render claims 30, 31, and 40 obvious.

Claims 30 and 40

Claims 30 and 40 recite “wherein the portable consumer device is a smartcard that conforms to ISO standard 7816.” According to the Office Action, *Fowler* does not teach that a smartcard that conforms to ISO standard 7816, “but Official Notice is taken that it is old and well known to have smart cards that conforms to ISO standard 7816.” (Office Action, page 9).

According to the MPEP and CCPA jurisprudence, “While ‘official notice’ may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of *instant and unquestionable demonstration* as being well-known. (MPEP 2144.03, citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970))(emphasis added).

Here, Appellant submits that whether smartcards conformed to the ISO standard 7816 as of the filing date of the subject application (September 30, 2003) is not capable of instant and unquestionable demonstration as being well-known.

The MPEP and CCPA jurisprudence continues: “assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.” (MPEP 2144.03, citing *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21).

Here, Appellant submits that the Examiner’s allegation regarding a technical standard is an assertion of “technical facts” and smartcard technology was “esoteric” as of September 30, 2003. Accordingly, the Examiner’s assertion “*must always* be supported by

citation to some reference work recognized as standard in the pertinent art.” (*Id.*)(emphasis added)

For at least these reasons, Appellant submits that the Examiner’s taking of Official Notice is improper. Accordingly, the Examiner has failed to establish a prima facie case of obviousness for claims 30 and 40 and, for at least this reason, withdrawal of the outstanding rejection to claims 30 and 40 is respectfully requested.

## **8. CONCLUSION**

For these reasons, it is respectfully submitted that the rejections should be reversed.

Respectfully submitted,

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## **9. CLAIMS APPENDIX**

Claims 1.-20. (canceled).

Claim 21. A method comprising:

receiving information at a host server computer about a first pre-existing offline reward program created by a first merchant, wherein the first pre-existing offline reward program provides for a first reward when a first product is purchased at the first merchant;

receiving information at the host server computer about a second pre-existing offline reward program created by a second merchant, wherein the second pre-existing offline reward program provides a second reward when a second product is purchased at the second merchant; and

using the host server computer, providing for a combination reward program that is linked to the first pre-existing offline reward program and the second pre-existing offline reward program and that provides a combination reward that is based on the purchase of at least the first product and the second product, wherein the combination reward program is provided by a reward sponsor, wherein the first merchant is different than the second merchant, and wherein the combination reward is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location, and wherein the first pre-existing offline reward program is capable of running without being in contact with the host server computer, and wherein the second pre-existing offline reward program is capable of running without being in contact with the host server computer;

wherein the portable consumer device includes a dynamic data field that may be updated based on a product preference of the consumer.

Claim 22. The method of claim 21 further comprising:  
providing the combination reward to the consumer at the first merchant at the first location, wherein the combination reward can be used at the second merchant at the second location.

Claim 23. The method of claim 22 wherein the portable consumer device is a smart card and wherein the combination reward is in the form of a coupon.

Claim 24. The method of claim 21 wherein the combination reward is an extension of time to receive at least one of the first reward and the second reward.

Claim 25. The method of claim 21 wherein the combination reward program is created by the reward sponsor that is affiliated with the first merchant and the second merchant.

Claim 26. The method of claim 21 wherein the combination reward program reduces or eliminates the combination reward, if a third product that is different than the first product and the second product, is purchased.

Claim 27. The method of claim 21 wherein the combination reward gives the consumer access to a special program earlier than another consumer that has not purchased the first product and the second product.

Claim 28. The method of claim 21 wherein the method further comprises:  
sending code for the combination reward program to a first access device operated by the first merchant and a second access device operated by the second merchant.

Claim 29. The method of claim 21 wherein the first product and the second product are made by the same manufacturer.

Claim 30. The method of claim 21 wherein the portable consumer device is a smartcard that conforms to ISO standard 7816, wherein the smartcard includes a dynamic data

field that is updated each time the first, second, and combination reward programs accumulate or redeem rewards.

Claim 31. The method of claim 21 wherein the portable consumer device includes a dynamic data field that is updated each time the first, second, and combination reward programs accumulate or redeem rewards.

Claim 32. A computer readable medium comprising code executable by a host server computer to implement a method comprising:

receiving information at a host server computer about a first pre-existing offline reward program created by a first merchant, wherein the first pre-existing offline reward program provides for a first reward when a first product is purchased at the first merchant;

receiving information at the host server computer about a second pre-existing offline reward program created by a second merchant, wherein the second pre-existing offline reward program provides a second reward when a second product is purchased at the second merchant; and

using the host server computer, providing for a combination reward program that is linked to the first pre-existing offline reward program and the second pre-existing offline reward program and that provides a combination reward that is based on the purchase of at least the first product and the second product, wherein the combination reward program is provided by a reward sponsor, wherein the first merchant is different than the second merchant, and wherein the combination reward is an award in addition to the first award and the second award and is given to a consumer in addition to the first award and the second award if the consumer uses a portable consumer device to purchase the first product at the first merchant at a first location and to purchase the second product at the second merchant at a second location, and wherein the first pre-existing offline reward program is capable of running without being in contact with the host server computer, and wherein the second pre-existing offline reward program is capable of running without being in contact with the host server computer;

wherein the portable consumer device includes a dynamic data field that may be updated based on a product preference of the consumer.

Claim 33. (canceled)

Claim 34. The computer readable medium of claim 32 wherein the combination reward is an extension of time to receive at least one of the first reward and the second reward.

Claim 35. The computer readable medium of claim 32 wherein the combination reward program is created by the reward sponsor that is affiliated with the first merchant and the second merchant.

Claim 36. The computer readable medium of claim 32 wherein the combination reward program reduces or eliminates the combination reward, if a third product that is different than the first product and the second product, is purchased.

Claim 37. The computer readable medium of claim 32 wherein the combination reward gives the consumer access to a special program earlier than another consumer that has not purchased the first product and the second product.

Claim 38. (canceled)

Claim 39. The computer readable medium of claim 32 wherein the method further comprises:

sending code for the combination reward program to a first access device operated by the first merchant and a second access device operated by the second merchant.

Claim 40. The computer readable medium of claim 39 wherein the portable consumer device is a smartcard that conforms to ISO standard 7816, wherein the smartcard includes a dynamic data field that is updated each time the first, second, and combination reward programs accumulate or redeem rewards.

Claim 41. The computer readable medium of claim 32 wherein the combination reward is of greater value than the first reward or the second reward.

Claim 42. The method of claim 21 wherein the combination reward is of greater value than the first reward or the second reward.

Claim 43. The method of claim 21, wherein the host server computer is hosted by a credit card processing company.

Claim 44. The method of claim 21, wherein the reward sponsor is a credit, debit, or smart card issuer.

Claim 45. The method of claim 27, wherein the special program is a reward program provided by a credit card processing company.

Claim 46. The method of claim 21, wherein the portable consumer device is a mobile phone with a microprocessor that communicates with a card acceptance device.

Claim 47. The method of claim 21, wherein each portable consumer device is associated with a different consumer.

Claim 48. The method of claim 21, wherein each portable consumer device is embossed with consumer identification information.

Claim 49. The method of claim 21 further comprising customizing future reward redemption and accumulation based on the product preference of the consumer.

Claim 50. The method of claim 21 wherein the combination reward is provided to the consumer via a reduction in the price of the second product.

Claim 51. The computer readable medium of claim 32 wherein the method further comprises customizing future reward redemption and accumulation based on the product preference of the consumer.

Claim 52. The computer readable medium of claim 32 wherein the combination reward is provided to the consumer via a reduction in the price of the second product.



**10. EVIDENCE APPENDIX**

None.

**11. RELATED PROCEEDINGS APPENDIX**

None.